

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

CIVIL ACTION NO. 10-10951-RWZ

SMITH & NEPHEW, INC.

v.

INTERLACE MEDICAL, INC.,
and
HOLOGIC, INC.

CIVIL ACTION NO. 11-12064-RWZ

SMITH & NEPHEW, INC.

v.

HOLOGIC, INC.

QUESTIONS TO JURY ON SPECIAL VERDICT

Infringement - Preponderance of the Evidence

1. Did defendant infringe Claim 32 of the '459 patent?

☒ YES ☐ NO

Please answer next Questions 2(a) and 2(b).

2(a). Did defendant intentionally induce physicians to infringe one or more of the asserted claims of the '359 patent?

Claim 5	<u>✓</u> YES	<u> </u> NO
Claim 6	<u>✓</u> YES	<u> </u> NO
Claim 7	<u>✓</u> YES	<u> </u> NO
Claim 8	<u>✓</u> YES	<u> </u> NO

2(b). Did defendant contribute to the physicians' infringement of one or more of the asserted claims of the '359 patent?

Claim 5	<u>✓</u> YES	<u> </u> NO
Claim 6	<u>✓</u> YES	<u> </u> NO
Claim 7	<u>✓</u> YES	<u> </u> NO
Claim 8	<u>✓</u> YES	<u> </u> NO

Please answer next Questions 3 - 7.

Validity - Clear and Convincing Evidence

Priority Date

3(a). Did defendant prove that the written descriptions in the Dutch Patent Application, the PCT Application and/or the '602 Application do not support the claims of the '359 patent so that plaintiff is not entitled to an earlier priority date?

 YES ✓ NO

If you answered NO, please answer next Question 3(b).

If you answered YES, please go to Question 4(a).

3(b). Which of the applications listed above provides the earliest priority date?

- | | | |
|-------|------------------------------|-------------------|
| (i) | the Dutch Patent Application | <u> </u> |
| (ii) | the PCT Application | <u> ✓ </u> |
| (iii) | the '602 Application | <u> </u> |

Anticipation

4(a). Is Claim 32 of the '459 patent invalid because the claimed device was anticipated by the Middle patent?

 YES ✓ NO

4(b). Are one or more of the asserted claims of the '359 patent invalid because one or more of the claims were anticipated by plaintiff's sales of the True Clear System more than one year before the priority date?

Claim 5	<u> </u> YES	<u> ✓ </u> NO
Claim 6	<u> </u> YES	<u> ✓ </u> NO
Claim 7	<u> </u> YES	<u> ✓ </u> NO
Claim 8	<u> </u> YES	<u> ✓ </u> NO

Obviousness

5(a). Is Claim 32 of the '459 patent invalid because, in light of the Middle patent, the claimed device was obvious to an ordinary person skilled in the art at the time the invention was made?

 YES ✓ NO

5(b). Are one or more of Claims 5, 6, 7 and 8 of the '359 patent invalid because, in light of the Grinsberg patent and the Olympus Nephroscope, the claimed method was obvious to an ordinary person skilled in the art at the time the invention was made?

Claim 5	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 6	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 7	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 8	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO

Enablement

6. Are one or more of the asserted claims of the '359 patent invalid for failing to satisfy the enablement requirement?

Claim 5	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 6	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 7	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 8	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO

Written Description

7. Are one or more of the asserted claims of the '359 patent invalid for failing to satisfy the written description requirement?

Claim 5	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 6	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 7	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO
Claim 8	<input type="checkbox"/> YES	<input checked="" type="checkbox"/> NO

If you found infringement of one or more claims of one or both patents and also found that those claims are valid, please answer next the Questions concerning damages. That is, if you answered YES to Question 1, Question 2(a), and/or Question 2(b) and NO to each corresponding part of Questions 4 through 7, please answer next the corresponding questions concerning damages.

If you found either no claims to be infringed by answering NO to Question 1 and all parts of Question 2, or if you found all infringed claims to be invalid, please return your verdict to the court.

Damages - Preponderance of the Evidence

Lost Profits

8. Is plaintiff entitled to lost profits on one or both patents?

(a) '459	<input checked="" type="checkbox"/> YES	<input type="checkbox"/> NO
(b) '359	<input checked="" type="checkbox"/> YES	<input type="checkbox"/> NO

If you answered YES as to one or both patents, please answer the corresponding part of Question 9.

If the answer to Question 8 is NO as to one or both patents, please answer Questions 10 and 11 as to the patent(s) to which you answered NO.

9. What is the amount of lost profits as to each patent?

(a) '459 patent	\$ _____	} \$4 million
(a) '359 patent	\$ _____	

If the answer to Question 8 is YES as to both patents and you have answered Question 9 as to both, please return your verdict to the court.

Reasonable Royalty

10. What is the reasonable royalty for infringement of one or both patents?

(a) '459 patent % 16

(a) '359 patent % 16

11. For those sales infringing one or both patents for which plaintiff is not entitled to lost profits, what is the dollar amount of the damages based on a reasonable royalty?

(a) '459 patent \$ _____

(a) '359 patent \$ _____

9/4/2012
Date

Joseph Lee
For person